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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,627	10/14/2003	Martin Ball	D/A1547	3743

25453 7590 01/17/2006

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ROCHESTER, NY 14644

EXAMINER	
YANG, CLARA I	

ART UNIT	PAPER NUMBER
2635	

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	**Application No.** 10/684,627	**Applicant(s)** BALL, MARTIN	
	Examiner Clara Yang	**Art Unit** 2635	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

 4a) Of the above claim(s) *9-17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 18-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *14 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

 a)☐ All b)☐ Some * c)☐ None of:

 1.☐ Certified copies of the priority documents have been received.

 2.☐ Certified copies of the priority documents have been received in Application No. _____.

 3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

 * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed on 17 November 2005 with respect to the 35 USC § 102(b) rejection of claim 1 as being anticipated by Walter (US 6,275,141) have been considered but are moot in view of the new ground(s) of rejection.

2. Applicant's arguments filed on 17 November 2005 with respect to the 35 USC § 102(e) rejection of claim 1 as being anticipated by Mahoney et al. (US 6,772,945) have been fully considered but they are not persuasive.

On page 7, the applicant argues that the examiner "has not shown where Mahoney discloses allowing/disallowing access to a device" and that "the passages recited by the Examiner relate to allowing access to a print job, which is not related to the feature of a device or the ability to access a device." The examiner respectfully disagrees. First, Mahoney's printer 16 has a plurality of features, such as one-sided printing and two-sided printing (see Col. 6, lines 9-14). When a user's data card 50 lacks proper authorization/authentication data, Mahoney teaches that the user is denied access to a print job (see Col. 4, lines 20-26 and Col. 5, lines 11-18 and 59-64). In other words, when Mahoney's printer 16 scans data card 50 via receiving portal 52 and determines that data card 50's printed indicia 53 fails to match any of the authorized data stored in a data file, a user is denied access to printer 16's printing function and thus to the features of one-sided or two-sided printing. Thus Mahoney does teach all the limitations of claim 1, and the examiner maintains the 35 USC § 102(e) rejection of claims 1, 3, 4, and 6.

In response to applicant's argument on page 8 that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "that the scanning is done with the scanner of the device itself") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Claim 1 has been amended to call for "optically scanning a tag with the device scanner" but omits expressly calling for the device scanner to scan both tags and documents. In the preamble, the "device scanner" simply defined as a scanner "that is used for scanning images into memory". Mahoney's printer 16 has a receiving portal 52 that is incorporated with printer 16 (see Figs. 1 and 3) and is a bar code scanner (see Col. 5, lines 50-58). Upon scanning data card 50's printed indicia 53 (i.e., an image), the scanned indicia must be temporarily stored in a memory for comparison with authorization data stored in a data file (see Col. 5, 59-64). Thus, claims 1-8 remain rejected under 35 USC § 103(a) as being unpatentable over Akiyoshi (US 2003/0086111) in view of Mahoney.

Claim Objections

3. Claim 24 is objected to because of the following informalities:

- ➢ Change "a tag placed in front of the scanner the scanner" to "a tag placed in front of the scanner".
- ➢ Change "allowing access to at least some features of the device if they are a member" to "allowing access to at least some features of the device if the bearer is a member".
- ➢ Change "disallowing access to the at least some features of the device if they are not a member" to "disallowing access to at least some features of the device if the bearer is not a member".

Appropriate correction is required.

Double Patenting

4. Claims 1 and 3-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, and 9-12 of

copending Application No. 10/685,320. Although the conflicting claims are not identical, they are not patentably distinct from each other for the following reasons:

Application No. 10/684,627	Co-pending Application No. 10/685,320	
Claims	Claims	Comments/Remarks
1	1, 9, 10	Claim 1 of the co-pending application is broader than the one in application no. 10/684,627 but is further defined in claims 9 (that the device includes a scanner) and 10 (that a scanner is used to read the tag). Broader claims in a later application constitute as obvious double patenting of narrow claims in an issued patent. See *In re Van Ornum and Stang*, 214 USPQ 761, 766, and 767 (CCPA) and *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970). In the decision of *In re Van Ornum and Stang*, the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent. In the decision of *In re Vogel*, the generic application claim specifying "meat" was considered obvious double patenting of a narrow patent claim specifying "pork".
3	4	Claim 4 of the co-pending application is identical to claim 3 of application no. 10/684,627.
4	11	Claim 11 of the co-pending application is identical to claim 4 of application no. 10/684,627.
5	12	Claim 12 of the co-pending application is identical to claim 5 of application no. 10/684,627.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1, 3, 4, 6, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Mahoney et al. (US 6,772,945).

Referring to claims 1 and 6, claim 1 has been amended to require a "device scanner for scanning images into memory" such that a user can use or manipulate the images. The limitation "for scanning images into memory for use or manipulation by a user of the device", however, is not a positive limitation since it only requires the ability to so perform. In addition, the limitation is in the preamble, and the body of claim 1 does not depend on the preamble for completeness. Mahoney teaches a printer 16 (as called for in claim 6) having (1) a bar code reader (i.e., scanner) for scanning data card 50's indicia 53 (i.e., image) into a memory in order to authenticate the user (see Col. 4, lines 23-36 and 42-53; and Col. 5, lines 11-18 and 50-64) and (2) a plurality of features, such as the ability to print one-sided or two-sided documents (see Col. 6, lines 9-14). As called for in claim 1, Mahoney's method for controlling printer 16, as shown in Fig. 4, comprises the steps of: (a) optically scanning data card 50 with a card reader at step 62 before data card 50's user can print via printer 16 (see Col. 4, lines 62-66 and Col. 5, lines 50-58); (b) reading data card 50's information during the scanning process (see Col. 5, lines 50-58); and (c) determining from the scanned information whether the bearer of data card 50 can access printer 16 at step 64 (see Col. 1, lines 13-15, 20-23, and 57-61; and Col. 5, lines 59-64). When it is determined that a user can access printer 16, the user must be able to access printer 16's one-sided or two-sided printing feature. On the other hand, when it is determined that a user is to be denied access, the user is unable to access any of printer 16's printing features, namely one-sided and two-sided printing.

Regarding claim 3, Mahoney's data card 50 is a badge since data card 50 is a card and includes credential for authorization and authentication (see Col. 4, lines 42-55).

Regarding claim 4, Mahoney discloses that data card 50's indicia 53 can contain bar code symbols (see Col. 4, lines 23-26 and 56-62).

Referring to claim 24, Mahoney teaches a method comprising: (a) creating a data file within printer 16, which has a plurality of features such as one-sided and two-sided printing, wherein the data file contains information related to a set of authorized users within a particular unit (i.e., defined group) (see Col. 4, lines 30-36 and Col. 5, lines 11-16 and 50-64); (b) encoding indicia 53 onto each data card 50 (see Col. 4, lines 27-36, 42-53, and 62-66; and Col. 5, lines 50-64); (c) optically scanning data card 50 (see Fig. 4, step 62; Col. 4, lines 23-26, 47-53, and 62-66; and Col. 5, lines 6-10 and 50-58); (d) receiving information from data card 50 during the scanning process (see Col. 4, lines 42-45 and 62-67; and Col. 5, lines 1-10 and 55-64); (e) determining whether the bearer of data card 50 is one of the set of authorized individuals (see Fig. 4, step 64; Col. 4, lines 20-36; and Col. 5, lines 11-16 and 59-64); (f) allowing access to at least one-sided or two-sided printing (i.e., some features of printer 16) if the bearer is a member of the set of authorized individuals (see Fig. 4, step 66; Col. 4, lines 20-23 and 47-53; Col. 5, lines 11-16 and 50-64; and Col. 6, lines 4-14); and (g) denying access to printer 16's printing features if the bearer is not a member of the set of authorized individuals (see Col. 4, lines 20-23 and 47-53; and Col. 5, lines 11-16 and 50-64).

7. Claims 1, 6-8, 18-20, and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Harris (US 6,799,717).

Referring to claims 1, 7, 18-20, and 24, Harris teaches a digital transmitter device that has an input device, a display, and a scanner (see Col. 1, lines 28-29). Per Harris, digital transmitting devices include multi-functional products (MFPs) having the capability of scanning hardcopy documents, copying (i.e., document reproduction, as called for in claim 20), printing, etc., and a digital network copier (see Col. 1, lines 15-27). Harris also discloses that the digital transmitter device has additional features such as e-mail (as called for in claim 18) and facsimile capability (as called for in claims 7 and 19) (see Col. 1, lines 37-67; Col. 2, lines 1-10; and Col. 4, lines 26-32 and 48-54). Harris discloses a method comprising the steps of: (a) programming the digital transmitting device, which has a plurality of features (e.g., e-mail, facsimile, scanning, copying, printing, etc.), with information related to authorized individuals (i.e., a defined group or set of individuals) (see Col. 3, lines 56-62; Col. 4, lines 4-8; and Col. 5, lines 17-21 and 36-48), as called for in claim 24; (b) encoding information related to authorized individuals as tags that are printed onto a cover sheet and carried by authorized individuals (see Col. 2, lines 34-38 and 53-54; Col. 3, lines 56-62; Col. 4, lines 19-25; and Col. 5, lines 1-3 and 9-16), as called for in claim 24; (c) using the digital transmitting device's conventional scanner to optically scan the tags on the cover sheet when the cover sheet is place in front of the scanner (see Col. 4, lines 4-8 and 10-25; and Col. 5, lines 1-3), as called for in claims 1 and 24; (d) receiving information from the tags during the scanning process (see Col. 4, lines 19-25 and Col. 5, lines 9-16), as called for in claims 1 and 24; (e) determining whether a bearer of the tag is an authorized individual (i.e., is one of the set of individuals) (see Col. 4, lines 4-8 and 19-25; and Col. 5, lines 9-21), as called for in claims 1 and 24; (f) allowing access to at least some features of the digital transmitting device if the bearer is an authorized individual (see Col. 5, lines 17-21 and 26-48), as called for in claims 1 and 24; and (g) denying access to at least some features if the bearer is not an authorized individual (see Col. 5, lines 17-21 and 26-41), as called for in claim 1 and 24.

Regarding claim 6, as explained in the rejection of claims 1 and 24, Harris teaches that the digital transmitting devices include MFPs having the capability of scanning hardcopy documents, copying, printing, etc. (see Col. 1, lines 15-27; Col. 3, lines 63-67; and Col. 4, lines 63-67); thus Harris's digital transmitting device is a printing device.

Regarding claim 8, Harris discloses that the digital transmitting device is a scanner connected to a network in order to transmit the scanned document via facsimile or e-mail (see Col. 1, lines 15-27 and 37-67; Col. 2, lines 1-10; Col. 3, lines 50-55; and Col. 4, lines 26-32 and 48-54).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 1-8, 19, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akiyoshi (US 2003/0086111) in view of Mahoney et al. (US 6,772,945).

Referring to claims 1, 4, and 5, Akiyoshi teaches a compound machine 100 (i.e., device) having a scanner for scanning images into memory, and a plurality of features, such as a facsimile, a black and white line printer 101, and a color line printer 102 (see Section [0047]). Akiyoshi's method for controlling compound machine 100, as shown in Fig. 11, includes the steps of: (a) reading a user code from flashcard 207 with flashcard interface part 206 at step S1004 before the bearer of flashcard 207 can use compound machine 100 (see Fig. 2 and Section [0095]); (b) obtaining the user code from flashcard 207 during the reading process at step S1004 (see Section [0097]); and (c) determining from the user code whether the bearer of flashcard 207 can access any of the device's features at step S1006 (see Sections[0060], [0065]-[0067], [0081], [0082], [0098], and [0100]). Akiyoshi, however, is silent on authenticating a user via a badge having a machine-readable image, such as a bar code (as called for in claim 4) or glyphs (as called for in claim 5), that is optically scanned with a scanner (as called for in claim 1).

In an analogous art, as explained in the 35 USC 102(e) rejection of claim 1, Mahoney teaches all the limitations of claim 1 and further discloses that data card 50's indicia 53 can contain bar code symbols (see Col. 4, lines 23-26 and 56-62). Though Mahoney omits teaching that data card 50's indicia 53 can contain glyphs, the applicant teaches in Section [0022] of the specification that "[bar] codes and glyphs are well known in the art", and the statement is taken to be admitted prior art. Hence it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Mahoney's data card 50 such that it contains glyphs since glyphs provide efficient, aesthetically acceptable codes for recording digital data, especially for applications in which such machine readable data is to be recorded in visual juxtaposition with human readable information.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of Akiyoshi as taught by Mahoney since a badge with a machine-readable image, such as a bar code or glyphs, is a low-cost, reliable device that can be created on a temporary, semi-permanent, or as needed basis (see Mahoney, Col. 1, lines 36-45 and Col. 4, lines 27-55).

Regarding claim 2, Akiyoshi's method also includes the step of granting access to some but not all of compound machine 100's features (see Sections [0060], [0065]-[0067], [0081], and [0082]).

Regarding claim 3, Akiyoshi's flashcard 207 is a badge (see Sections [0093]-[0100]).

Regarding claims 6-8, 19, and 20, as explained in the 35 USC 103(a) rejection of claim 1, Akiyoshi's compound machine 100 has a scanner, which is used for document reproduction (as called for in claim 20) by scanning images into memory (as called for in claim 8) and a plurality of features, such as a facsimile (as called for in claims 7 and 19), a black and white line printer 101 (as called for in claim 6), and a color line printer 102 (as called for in claim 6) (see Sections [0047] and [0059]). As shown in Fig. 16, Akiyoshi teaches connecting a plurality of compound machines 100 by a local area network (LAN) (see Sections [0102], [0110], and [0111]).

11. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harris (US 6,799,717) as applied to claim 1 above, and further in view of Chow et al. (US 6,292,092).

Regarding claims 21 and 22, though Harris teaches using a digital transmitting device's conventional scanner to optically scan tags on a cover sheet and authenticate a user, as explained in the previous rejection of claim 1, Harris is silent on a tag containing an image of the bearer of the tags printed on a cover sheet, wherein the image is scanned and compared to a stored image in order to determine whether the user has access to the digital transmitting device

In an analogous art, Chow teaches an personal identification system, wherein a personal identity instrument or tag (e.g., passports, credit cards, driver's licenses, building passes, etc.), as shown in Fig. 2, includes: (1) area 1 providing biographical data of the legitimate holder of the tag, (2) area 2 providing a digital picture of the legitimate holder of the tag, and (3) area 3 providing authentication information encoded as a bar code (see Col. 2, lines 60-67 and Col. 3, lines 1-4). Chow specifies that the picture and the bar code are in machine-readable form (see Col. 3, lines 11-13). Chow further discloses that the authentication information includes information from the biographical data and from the digital picture (see Col. 3, lines 14-51) and that a commercial flatbed scanner, such as Hewlett-Packard Model IIc Scanjet, can be used to authenticate the tag (see Col. 4, lines 9-15 and Col. 5, lines 1-45). Chow's authentication method comprises the steps of: (1) scanning an identity tag using scanner 11; (2) acquiring the biographical information from area 1 converting the information into a binary format via processor 13; (3) extracting image descriptors from the picture in area 2; (4) reading the bar code and decrypting the bar code information using a public decryption key; (5) comparing the biographical information obtained from the decrypted bar code information with biographical information acquired from area 1; and (6) comparing the image descriptors obtained from the decrypted bar code information with the image descriptors obtained from area 2 and saved in a local memory (i.e., a stored image). (See Col. 5, lines 9-36.)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system and method of Harris as taught by Chow because using a picture in addition to using a bar code to authenticate a user two means of verifying a user enhances the security of the digital transmitting device.

Regarding claim 23, Harris, as modified by Chow, disclose that the tags on a cover sheet are not limited to bar codes, Harris and Chow fail to expressly teach that the tags can contain glyphs. However, the applicant teaches in Section [0022] of the specification that "[bar] codes and glyphs are well known in the art", and the statement is taken to be admitted prior art. Hence it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Harris and Chow's tag such that it contains glyphs since glyphs provide efficient, aesthetically acceptable codes for recording digital data, especially for applications in which such machine readable data is to be recorded in visual juxtaposition with human readable information.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clara Yang whose telephone number is (571) 272-3062. The examiner can normally be reached on 8:30 AM - 7:00 PM, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Horabik can be reached on (571) 272-3068. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CY
11 January 2006

BRIAN ZIMMERMAN
PRIMARY EXAMINER